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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/134,014	08/14/1998	WILHELM GRUISSEM	018941-00020	7338

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TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

FOX, DAVID T

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 03/19/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.



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Below is a communication from the EXAMINER in charge of this application
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☐ THE PERIOD FOR RESPONSE:

- a) ☐ is extended to run _____ or continues to run _____ from the date of the final rejection
- b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☒ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☐ Applicant's response to the final rejection, filed 3/11/03 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:

- a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
- b. ☐ They raise new issues that would require further consideration and/or search. (See Note).
- c. ☐ They raise the issue of new matter. (See Note).
- d. ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: item d: New claims do not follow the revised 37 CFR 1.121 per OG Notice published 2/25/03 because deleted item should be lined through ("strikethrough") rather than bracketed. New claims do not follow current 37 CFR 1.121 either.

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☒ Upon the filing an appeal, the proposed amendment ☐ will be entered ☒ will not be entered and the status of the claims will be as follows:

Claims allowed: _____

Claims objected to: _____

Claims rejected: 1-12

However;

☐ Applicant's response has overcome the following rejection(s): _____

4. ☒ The affidavit, exhibit, or request for reconsideration has been considered but does not overcome the rejection because see attachment

5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☐ Other

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Advisory Action. Item 4.

Applicants urge that the art rejections are improper because the secondary reference's modifications would render the primary reference's teachings inoperable and would change the operating principle of the primary reference; and because the cited art does not teach or suggest every claimed element, namely homologous recombination with the target plant DNA found in the fusion polynucleotide construct.

The Examiner maintains that Applicants' allegations of inoperability or change in operating principle are not substantive or persuasive. The Examiner repeats his position on page 5 of the last Office action that Applicants' evidence of unexpected results relies upon the use of a heterologous nucleic acid molecule comprising a promoterless fusion polynucleotide construct comprising at least one entire exon of the chloroplast *rbcL* gene ligated to a non-selectable reporter gene, said heterologous nucleic acid molecule further comprising a selectable marker gene comprising a promoter, said selectable marker gene outside of the fusion polynucleotide construct. In contrast, the claims are not limited to any particular "sequences necessary for expression", any particular "polypeptide sequence of interest"-encoding sequence, any particular type of reporter gene ligated thereto, or the use of an additional selectable marker gene for initial identification of transformed cells. It is further noted that the chloroplast genome is substantially smaller than the nuclear genome. See *Lindner* and *Grasselli* cited previously.

Regarding the recombination of target plant DNA found in the fusion polynucleotide construct with target plant DNA in the recipient plant cell's genome, the Examiner notes that the

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claims are not so limited. Claim 1, last paragraph merely recites that "homologous recombination has occurred between the introduced heterologous nucleic acid molecule and plant DNA". Any part of the heterologous nucleic acid molecule, including plant DNA portions outside of the fusion polynucleotide portion, would be available for recombination.

DAVID T. FOX
PRIMARY EXAMINER
GROUP 180 1638

A handwritten signature in black ink, appearing to read "David T. Fox", written in a cursive style.